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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/142,452

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OSKAR K. WACK

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EXAMINER

MARKOFF, ALEXANDER

ART UNIT

PAPER NUMBER

1792

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/142,452	<b>Applicant(s)</b> WACK ET AL.	
	<b>Examiner</b> Alexander Markoff	<b>Art Unit</b> 1792	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 146-165 is/are pending in the application.
- 4a) Of the above claim(s) 165 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 146-164 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of the claims 146-164 and the specie of the glycol ether and the specie of amino alcohol in the reply filed on 08/07/08 is acknowledged. The traversal is on the ground(s) that election of species is not proper for 371 applications. This is not found persuasive because the election of species is proper for 371 applications. Please, consult MPEP 1893.03(d). The traversal is also on the ground(s) that the claims contain corresponding technical features such as providing a cleaning composition and removing contaminants. This is not persuasive because the referenced features are not related to the election of different chemical species.

The requirement is still deemed proper and is therefore made FINAL.

2. As to the election of species:

The examiner acknowledges the election of dipropyleneglycolmono-n-propyl ether as the elected specie of glycol ethers.

The examiner acknowledges the election of 1-aminobutanol-2 as the specie of aminoalcohol.

The examiner would like to note that he did not require the election of species of amino alcohols since such were not claimed in the restricted claims 126-145.

However, since the referenced claims were canceled and replaced with claims 146-165, which recite different group of optional compounds including amino alcohols, the election is accepted for the prosecution.

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The examiner acknowledges the election of the specie of the composition that consist water, dipropyleneglycolmono-n-propyl ether and 1-aminobutanol-2.

Claims 146-152 recite not only composition consisting of water, glycol ether and an additional organic compound, but also a composition consisting of glycol ethers and water.

The examiner did not require the restriction between these species.

Thereby the election of the specific composition, which includes 1-aminobutanol-2, unnecessary limits these claims. These claims would be examined as presented.

The claims specifically requiring 1-aminobutanol-2 would be examined accordingly.

3. Claim 165 is withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 08/07/08.

### ***Specification***

4. The substitute specification filed 3/6/08 has been entered.
5. The substitute specification has been entered because of the provided explanation that the referenced Specification is more accurate and certified translation of the international application.
6. The amendment filed 3/6/08 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment

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shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The amendment changes the scope of the disclosure. The amendment removes the recitation of the azeotropic property as the essential property of the cleaning liquids.

Applicant is required to cancel the new matter in the reply to this Office Action.

7. The amendment to the specification filed 08/07/08 has not been entered because it does not correspond to the substitute specification filed 03/06/08.

***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 146-152 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The ranges for water and glycol ethers for the composition also comprising a non-specified amount of an additional organic compound, which are recited by the new claims 146-152 are not supported by the original disclosure.

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

11. Claims 146, 147 and 151 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 95/07974.

WO 95/07974 teaches a method as claimed. See entire document, especially pages 5-9 and 22.

12. Claims 146, 147 and 150-152 are rejected under 35 U.S.C. 102(a) as being anticipated by WO 96/28535.

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WO 96/28535 teaches a method as claimed. See entire document, especially pages 1, 2, 3, 10, 11, 14-20.

***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

15. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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16. Claims 148-149, 152-158, 160 and 162-164 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 95/07974.

WO 95/07974 teaches a method as claimed except for the specific recitation of aminobutanol and for claim 152 the cleaning temperature.

However, WO 95/07974 teaches inclusion a corrosion inhibitor and recites the use of close homologues of the claimed aminobutanol for the disclosed purpose.

It would have been obvious to an ordinary artisan at the time the invention was made to use aminobutanol in the method of WO 95/07974 with reasonable expectation of adequate results because WO 95/07974 teaches the use of homologs of the claimed chemical.

As to claim 152, WO 95/07974 teaches conducting the process at temperatures slightly above room temperature. It would have been obvious to an ordinary artisan at the time the invention was made to find an optimum cleaning temperature in the range of above the room temperature disclosed by WO 95/07974 by routine experimentation in order to enhance the process.

17. Claims 148-149 and 153-164 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 96/28535.

WO 96/28535 teaches a method as claimed except for the specific recitation of aminobutanol.

However, 96/28535 teaches inclusion a corrosion inhibitor, teaches a genus, which includes the claimed chemical, and recites the use of close homologues of the claimed aminobutanol for the disclosed purpose.



It would have been obvious to an ordinary artisan at the time the invention was made to use aminobutanol in the method of 96/28535 with reasonable expectation of adequate results because 96/28535 teaches the use of teaches a genus, which includes the claimed chemical, and homologs of the claimed chemical.

### ***Response to Arguments***

18. Applicant's arguments filed 08/07/08 have been fully considered but they are not persuasive. The applicants amended the claims, which were introduced after the previous Office action on the merits and allege that the referenced claims are allowable. This is not persuasive for the reasons provided above.

19. The Declaration filed on 5/21/03 under 37 CFR 1.131 has been considered but is ineffective to overcome the WO 96/28535 reference. Because the presented data is not commensurate in scope with the pending claims.

### ***Conclusion***

20. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Markoff whose telephone number is 571-272-1304. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Barr can be reached on 571-272-1414. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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